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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,892	03/23/2001	Verivada Chandru Chandrasekaran	BSCO115540	7893
26389	7590	09/22/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,892

Applicant(s)

CHANDRESEKARAN ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24, 26-31 and 33-48 is/are pending in the application.
- 4a) Of the above claim(s) 17, 19-23 and 38-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 24, 26-31, 33-37, and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 24, 26-31, 33, 34, 36, 37, and 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alt, US 6,099,561. The outermost layer or barrier **80** is disclosed as being an oxide, hydroxide, or nitrate of a noble metal (column 11, lines 40-43; claims 21, 22, and 38; etc.), with examples being iridium oxide and titanium nitrate (titanium being more noble than metals such as magnesium, zinc, and aluminum). Regarding claims 18, 26, and 27, the particular oxides, nitrides, and carbides were well known in the art and would have been obvious variants in view of their similar purposes (column 10, lines 1-13) and in the absence of any supposed criticality or advantage (in the Applicant's disclosure) of one material over another (*In re Kuhle*, 188 USPQ 9). Regarding claims 28-31: column 10, lines 23-26; Figure 2; etc. Regarding claims 33, 34, and 36, the materials (column 7, lines 44-49) for the structural member **11** provide a fraction (albeit a small one) of x-ray absorption (column 2, lines 48-50; column 4, lines 13-14); alternatively, the core may be viewed as additionally comprising the layer **50** of noble metal or alloy (column 9, lines 1-10). Regarding claim 37: column 3, line 31; etc.

Claims 18, 24, 27, 28, 33-36, and 44-48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Davidson, US 5,685,306: column 6, lines 7-10 and 40-47; column 7, lines 56-60; column 11, lines 59-64; column 12, lines 36-38 and 46-47; column 13, lines 25-28; column 14, lines 17-18 and 63-67; etc.

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Claims 26, 29-31, 37, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson, US 5,685,306. Regarding claim 26, tantalum nitride, for example, would have been immediately obvious, if not inherent, from column 6, lines 9-10, and column 14, lines 17-18. Regarding claims 29-31, micro-pores or grooves or the like would have been obvious in order to help affix the optional medicament coating (e.g., column 7, lines 56-60). Regarding claim 37, a coronary stent would have been obvious from column 13, lines 14-15, and from the various disclosed examples pertaining to the treatment of the heart.

The Applicant's remarks have been reviewed. In regard to the Alt patent, the Applicant's own disclosure encompasses "oxy-nitrides" of titanium (paragraph 0029 of US 2002/0138136) and indicates that "[t]he outer layer 134 may also include platinum, iridium and their alloys" and that "any bio-compatible polymer may be used". The specification is silent as to any supposed advantages of the claimed materials over the other disclosed materials. Regarding the Davidson patent, according to the Applicant's response to the election requirement, received on December 12, 2002, claims 18 and 24-37 are readable on the elected species corresponding to Figure 5. Therefore, the examiner need not equate the diffusion hardened surface with the claimed "first portion" (contrary to what is assumed by the Applicant at page 7, lines 12-13, of the Applicant's response dated June 14, 2004), but can, in apparently the same manner as the Applicant, simply interpret the "first portion" as being a constituent metal (e.g., niobium or zirconium) of the core alloy. Attention is also directed to the Applicant's own claims 33 and 36.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under

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37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903, and as of November 2, 2004, will be (571) 272-4762. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
Art Unit 3738